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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,913	01/12/2001	David P. Biss	176/60930	2814
7590	12/31/2003		EXAMINER	
Gunnar G. Leinberg, Esq. NIXON PEABODY LLP Clinton Square P.O. Box 31051 Rochester, NY 14603				SHAFER, RICKY D
		ART UNIT	PAPER NUMBER	2872
DATE MAILED: 12/31/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/759,913	Applicant(s) BISS ET AL.
	Examiner Ricky D. Shafer	Art Unit 2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 June 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-87 is/are pending in the application.
4a) Of the above claim(s) 1-61, 67-76 and 82-87 is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 62, 63, 77 and 78 is/are rejected.
7) Claim(s) 64-66 and 79-81 is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 30 April 2001 is/are: a) accepted or b) objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). ____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) Other: ____ .

Art Unit: 2872

1. Applicant's election with traverse of invention II (claims 62-87) and species "A", depicted by Fig. 1, in Paper No.12 is acknowledged. The traversal is on the ground(s) that the search and examination of some of the nonelected invention and species along with the elected invention and species would not appear to be a "serious burden". This is not found persuasive because applicant's remarks on page 2, lines 4-19 generally confuse the subjective issue of "undue burden" on the examiner with the issue of noncoextensive searches. The latter is an adequate and objective basis for supporting separate status in the art in turn supports restriction as set out in M.P.E.P. section 808.02. The issue is not whether the search per se is an undue burden. The issue is whether the patentably distinct inventions have a separate status as shown by separate classification, search, or otherwise.

If one were to consider the issue burden to be addressable to supersede normal standards for determining separate status in the art fully supporting restriction, one must conclude applicant has failed to properly address that issue. Search per se is a poor measure of burden because it relates to only a small part of the examination process which is the relevant issue concerning burden. M.P.E.P. section 803 recites: "If the search and examination of an entire application can be made with out serious burden..."(emphasis added). Applicant's remarks ignore all aspects of examination, such as 35 USC 101,102,103,112, first and second paragraphs, formal matters, etc., by original presentation and/or likely to develop throughout the prosecution.

Art Unit: 2872

In addition, searches now commonly include automated data base searches which generally require substantially different keyword searches for patentably distinct inventions which increases the burden of dual examination.

The restriction requirement, set forth in Paper No.11, clearly demonstrates the distinctness and burden between each of the patentably distinct inventions. Continued search and examination of claims to a nonelected invention/species including claims having substantially different structural limitations is a Prima Facie showing of burden. Applicant may overcome the requirement for restriction by presenting an allowable linking claim (see M.P.E.P.. 809.04) or by providing a clear admission on the record that the claim(s) drawn to a given non-elected invention/species is not patentably distinct form the elected invention. See M.P.E.P. 803.

The requirement is still deemed proper and is therefore made FINAL.

2 Claims 1-61, 67-76 and 82-87 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2872

4. Claims 62 and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Corle et al ('317).

Corle et al discloses a microscope comprising a source (3, 53) for a homogeneously polarized input optical beam, a polarization converter (17, 17', 69) which produces an inhomogeneously polarized optical beam from the homogeneously polarized input optical beam and a microscopic imaging system (33, 83) which captures an image of a sample (21) using the inhomogeneously polarized optical beam. Note figures 1, 4 and 6 along with the associated description thereof.

5. Claims 62 and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Oldenbourg et al ('705).

Oldenbourg et al discloses a microscope comprising a source (10, 10', 10'') for a homogeneously polarized input optical beam, a polarization converter [(24, 26), (24', 26'), (24'', 26'')] which produces an inhomogeneously polarized optical beam from the homogeneously polarized input optical beam and a microscopic imaging system (16, 16', 16'') which captures an image of a sample (38, 38'', 38'') using the inhomogeneously polarized optical beam. Note figures 1 to 3 along with the associated description thereof.

6. Claims 62 and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Kusaka ('127).

Kusaka discloses a microscope comprising a source (51) for a homogeneously polarized input optical beam, a polarization converter (54) which produces an inhomogeneously polarized

Art Unit: 2872

optical beam from the homogeneously polarized input optical beam and a microscopic imaging system (110, 111) which captures an image of a sample (57) using the inhomogeneously polarized optical beam. Note by example only Fig. 12 along with the associated description thereof.

7. Claims 62, 63, 77 and 78 are rejected under 35 U.S.C. 102(b) as being anticipated by Koester ('808).

Koester discloses a microscope comprising a source (22) for a homogeneously polarized input optical beam, a polarization converter (54) including a first polarization beam splitter (3), a first phase shifter (32a), a second phase shifter (32b) and a second polarization beam splitter, wherein said polarization converter produces an inhomogeneously polarized optical beam from the homogeneously polarized input optical beam and a microscopic imaging system (the photocell) which captures an image of a sample (34a) using the inhomogeneously polarized optical beam. Note by example only Fig. 3 along with the associated description thereof.

8. Claims 64-66 and 79-81 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The drawings are objected to because the polarized light beams outputted from the polarization beam splitter (34), shown in Fig. 1, are improperly illustrated. It is well known that the polarization beam splitter, as shown in Fig. 1, reflects one polarization component and transmits the other polarization component. Therefore, the different polarization components O

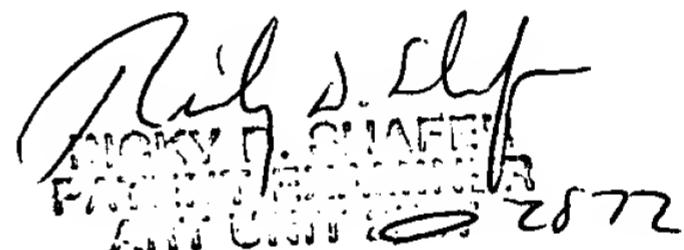
Art Unit: 2872

and O shown between mirror and polarization beam splitter (34) can not both be reflected by the polarization beam splitter (34) A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

10. Any inquiry concerning this communication should be directed to R.D. Shafer at telephone number (703) 308-4813.

RDS

December 28, 2003



R.D. Shafer
R.D. SHAFER
FEB 28 2004 2872